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Cooper & Dunham, LLP
1185 Avenue of the Americas
New York, New York 10036

In re Application of: :
YAN et al. :
U.S. Application No.: 10/577,382 :
PCT No.: PCT/US04/36173 :
International Filing Date: 28 October 2004 : DECISION ON PETITIONS
Priority Date: 31 October 2003 :
Attorney's Docket No.: 68548-PCT-US/JPW/JW :
For: METHODS FOR REDUCING :
SEIZURE-INDUCED NEURONAL :
DAMAGE :

This decision is issued in response to applicants' "Petition to Revive an Unintentionally Abandoned Application under 37 CFR 1.137(b)" filed 11 February 2008. Additionally, this decision is issued in response to applicants' facsimile communication dated 17 June 2008.

BACKGROUND

On 28 October 2004, applicants filed international application PCT/US04/36173 which claimed a priority date of 31 October 2003 and which designated the United States. The deadline for submitting the basic national fee was thirty months from the priority date, i.e., 01 May 2006.

On 27 April 2006, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 08 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e).

On 12 April 2007, applicants filed a "Communication in Response to January 8, 2007 Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office and Petition for a One-Month Extension of Time" which included five pages of declaration materials and a statement that "the subject application does not contain any nucleotide or amino acid sequences as defined in 37 CFR 1.821."

On 04 September 2007, the DO/EO/US mailed a Notification Of Defective Response (Form PCT/DO/EO/916) indicating that the filed declaration was defective because "the declaration document appears to be a compilation of a number of separate declaration documents." The Notification indicated that the failure to file a proper response within one month would result in abandonment of the application.

On 09 October 2007, applicants filed "Communication in Response To September 4, 2007 Notification Of Defective Response" which was treated as a Petition under 37 CFR 1.181. The petition was dismissed without prejudice in a Decision on Petition dated 07 December 2007 and the application was held ABANDONED for failing to file a proper response to the Notification of Missing Requirement. Specifically, the declaration of inventorship was not in compliance with 37 CFR 1.497(a)-(b) and MPEP § 201.03.

On 11 February 2008, applicants filed "Petition to Revive an Unintentionally Abandoned Application under 37 CFR 1.137(b)" which included a declaration(s) executed by two of three joint inventors (Exhibits A and B).

On 17 June 2008, applicants resubmitted the "Petition to Revive an Unintentionally Abandoned Application under 37 CFR 1.137(b)" which included declaration(s) executed by the three joint-inventor (Exhibits A, B, and C) and a copy of the date-stamped filing receipt dated 11 February 2008. (This submission will be treated as a Petition under 37 CFR 1.181.)

DISCUSSION

Petition under 37 CFR 1.181

The petition filed 11 February 2008 does not include the declaration and power of attorney executed by David Stern (Exhibit C of the petition filed 11 February 2008). The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. (See Manual of Patent Examining Procedure §503.) Applicants' 17 June 2008 submission included a copy of their date-stamped filing receipt. The receipt identifies the application by application number, attorney docket number, and filing date. The receipt itemizes, among other things, three signed Declarations and Power of Attorneys (Exhibits A, B, and C). The receipt is stamped "Rec'd. OIPE FEB 11, 2008" across its face is sufficient to indicate that three signed Declarations and Power of Attorneys (Exhibits A, B, and C) were in fact received in the Office on 11 February 2008.

Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this

paragraph was unintentional,” and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was a Declaration(s) and Power of Attorney executed by the three joint-inventors. Item (1) is satisfied.

As to Item (2), the appropriate petition fee of \$1540.00 as required by 37 CFR 1.17 was submitted.

With regard to Item (3), applicants’ statement that “entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional” complies with 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

The petition under 37 CFR 1.181 is **GRANTED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is 11 February 2008.



Anthony Smith
Attorney-Advisor
Office PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459